

Response Dated January 26, 2004
Reply to Office Action of December 22, 2003
Application. No. 09/933,858

REMARKS

The Examiner is thanked for the review of the application and the indications that Claims 31-41 are allowable as well as Claims 3-25 and 30 if they were written in independent form. Claims 1-41 are pending.

Claim Objections

Claim 9 was objected to for containing a clerical error wherein Claim 9 depended from itself. Claim 9 has been amended to depend from Claim 8.

Claims 27 and 29 were objected to under 37 CFR 1.75(c) as containing identical limitations. Claim 27 has been amended to differentiate the respective claim scopes of Claims 27 and 29.

Neither the amendment to Claim 8 or to Claim 27 is a narrowing amendment; rather they are each corrective amendments meant to place each claim in its proper initial form.

Obviousness-Type Double Patenting Rejection

Claims 1-2 and 26-29 were also rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Design Patent No. D470,135 S, to Buesseler et al. (hereinafter "*Buesseler*").

In regard to the obviousness-type double patenting rejection of Claims 1-2 and 26-29, applicants respectfully submit that obviousness-type double patenting does not apply between *Buesseler* and Claims 1-2 and 26-29. *Buesseler* merely illustrates the ornamental design for an interchangeable cover of mobile phone. In contrast, the

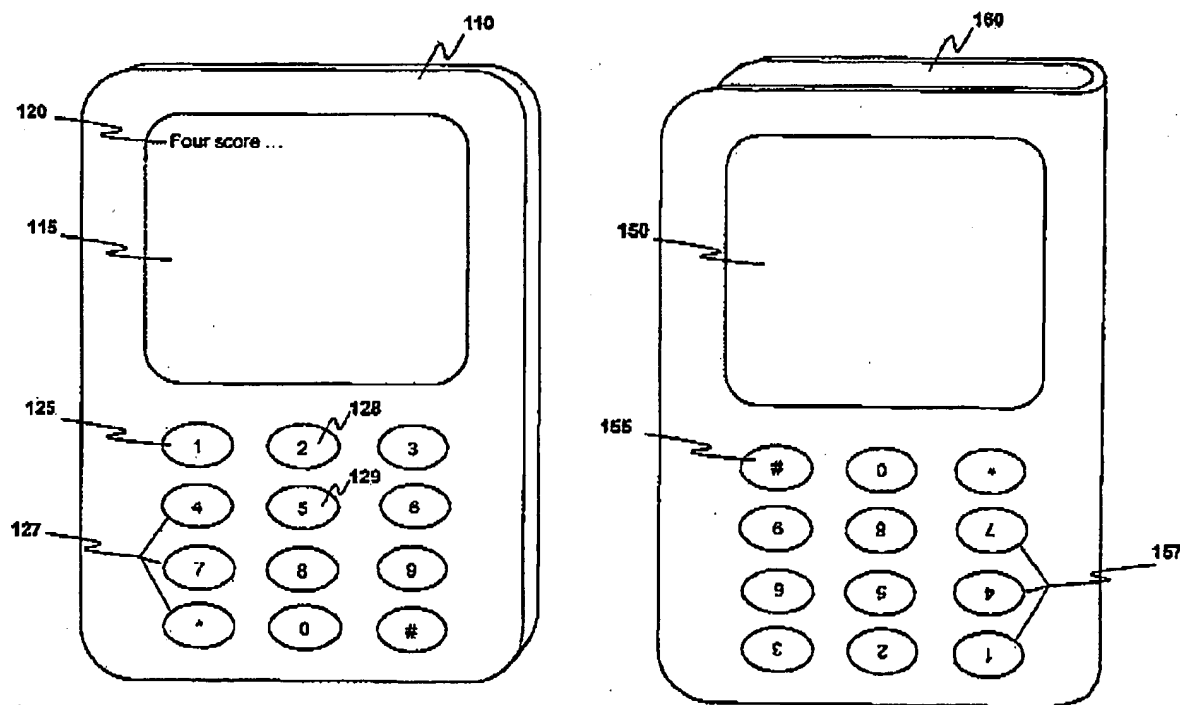
Attorney Docket No. 109909-129577
IPG No. P024

SEA/109909/129577/AKP/321015.1

12/16

Response Dated January 26, 2004
Reply to Office Action of December 22, 2003
Application. No. 09/933,858

Claims 1-2 and 26-29 of the present application are directed to the functional aspects of a mobile communications device. While the figures of *Buesseler* are similar to the figures in the present applications, *Buesseler's* claim is directed to the ornamental design and aspects as shown in *Buesseler's* figures, i.e., "the visual characteristics or aspect displayed by the article" (MPEP 1502). In contrast, the scopes of Claims 1-2 and 26-29 cover other interchangeable covers not taught, suggested or claimed by *Buesseler* as it is directed to "the way the article is used and works" (MPEP1503). See for example the following sample drawing A.



DRAWING A

Response Dated January 26, 2004
Reply to Office Action of December 22, 2003
Application. No. 09/933,858

An interchangeable cover 160 as shown in drawing A, comprised of a resilient semi-rigid material, falls squarely within the scope of Claim 1 of the present application.

1. An interchangeable cover for a mobile communications device comprising:

a resilient semi-rigid shell including a front face and back face commonly connected to a side portion and having a substantially U-shaped profile adapted to wrap around a substantial portion of a front, back and side of the mobile communications device upon assembly over the mobile communications device.

However, it is equally clear that the interchangeable cover 160 of Drawing A, whether or not comprised of a resilient semi-rigid material, fails to render obvious the ornamental design of *Buesseler*. Looking at the interchangeable cover 160 of Drawing A, there is no teaching or suggestion of the visual characteristics or aspect displayed by the interchangeable cover shown in Figures 1-7 of *Buesseler* other than a U-shaped profile. It is clear from these figures that many ornamental aspects of *Buesseler*, (e.g., the curved nature of the cover, the shape and orientation of perforations and/or buttons, the contours, etc.) are not obvious from Claim 1 of the present application.

Courts have generally frowned upon using design patents as the grounds of obviousness-type double patenting rejects, as courts correctly recognize that claims to ornamental designs and claims to functional aspects of the same implementation of an invention may vary dramatically in scope, as is the case here.

In applying the above tests, there is a heavy burden of proof on one seeking to show double patenting. Double patenting is rare in the context of utility versus design patents. *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 941; 220 U.S.P.Q. 481

Response Dated January 26, 2004
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Application. No. 09/933,858

In the rare instance, when a design patent is used in a double patenting rejection, it is proper to further determine if the design claimed in the design patent is functional or ornamental.

The proper inquiry for determining functionality of a design is whether the overall appearance of the design is dictated by a utilitarian or ornamental purpose. Such a distinction makes it possible to obtain both a utility patent and a design patent on the same article. *Carman Indus. v. Wahl*, 724 F.2d 932, 938-39 (Fed. Cir. 1983).

When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 117, 1123 (Fed. Cir. 1993).

As clearly seen between drawing A and the drawings of Buesseler, there are "several ways to achieve the function" of an interchangeable U-shaped cover for a mobile communications device. Accordingly it becomes even more clear that Buesseler's claim is to the ornamental design, and not to the functional aspects as claimed in the present application.

Additionally, in order for a design patent to be used in an obviousness-type double patenting rejection against a utility patent, it must pass a two-way double patenting test.

In these cases, a "two-way" test is applicable. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *In Re Dembiczak*, 175 F.3d 994, 1002; 50 U.S.P.Q.2D 1614

As already indicated above, Buesseler's Claim 1 and Claims 1-2 and 26-29 of the present application do not cross-read on each other. Thus, whether Buesseler's Claim 1 to the ornamental design of an interchangeable cover may encompass an

Attorney Docket No. 109909-129577
IPG No. P024

SEA/109909/129577/AKP/321015.1

15/16

Response Dated January 26, 2004
Reply to Office Action of December 22, 2003
Application, No. 09/933,858

interchangeable cover with the elements of Claim 1 of the present application is immaterial if obvious variations to *Buesseler's* Claim 1 do not cover all interchangeable covers within the scope of Claim 1 of the present application.

For the reasons mentioned above, applicants respectfully assert that Claims 1-2 and 26-29 do should not be rejected under judicially created obviousness-type double grounds. Accordingly, applicants request that the judicially created obviousness-type double patenting rejection of Claims 1-2 and 26-29 be withdrawn and the claims allowed.


CONCLUSION

In view of the foregoing, Applicants respectfully submit that Claims 1-41 are in condition for allowance. Thus, early issuance of a Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393. A Fee Transmittal is enclosed in duplicate for fee processing purposes.

Date: 1/26/04

Respectfully submitted,
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Attorney Docket No. 109909-129577
IPG No. P024
SEA/109909/129577/AKP/321015.1

16/16